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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David K. Lee

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EXAMINER

NELSON, FREDA ANN

ART UNIT

PAPER NUMBER

3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/928,292

Applicant(s)

LEE ET AL.

Examiner

Freda A. Nelson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The amendment received on October 23, 2006 is acknowledged and entered. Claim 1 has been amended. Claims 11-21 have been canceled. Claims 22-29 have been added. Claims 1-10 and 22-29 are currently pending.

#### ***Response to Amendments and Arguments***

Applicant's arguments filed October 23, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments that "the cited art does not disclose or anticipate the following steps of claim 1 as amended namely automatically detecting at the mail room the special service indicator on the mail item and determining the special service delivery required based on the detection of the special service indicator; applying at the mail room a unique office worker generated identifier to the mail item, the unique identifier including an electronic address of a company server; receiving from the carrier at the electronic address obtained by the carrier from the unique identifier on the mail item information relating to the location of the mail item", the examiner respectfully disagrees. Gelfer discloses "*the information contained in the identity certificate can be used by the carrier for delivering and billing purposes by reading the data from the identity certificate in a data center of the carrier before delivering the piece of mail. Further, an identity code for the piece of mail can be included in the identity certificate, selectively in readable form or as a bar code, which may be used for searching for a piece of mail in case of mailing errors (paragraph [0004]).*" Gelfer further

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*discloses "postal services, in particular postal administrations and private carriers, desire to offer a track and trace capability for certain classes of mail, for which purpose it is desired that any form of identification for pieces of mail be provided, e. g. that a bar code be printed in some manner during the creation of the postage meter indicia" (paragraph [0005]).*

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1 and 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 1, the examiner is unable to locate in the specification where the unique office worker generates the identifier.

As per claim 25, the examiner is unable to locate in the specification "first and second receptacles" and first and second receptacle identifiers".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the examiner is unable to determine by the claim language, what is meant by " a unique office worker".

Claim 1 recites the limitation "the unique identifier" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "the office worker generated mail item", "the carrier generated mail item identifier", "the carrier generated second receptacle identifier", and "the first and second carrier generated identifiers" " in lines 23, 24, 25 and 26, respectively. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer (US PG Pub. 2002/0046194) in view of Baghai et al. (US Patent Number 5,905,868).

As Per Claim 1, Gelfer discloses a method for tracking a special service delivery by a carrier of a mail item created by an office worker, the method comprising the steps

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of: applying a special service indicator, (identity certificate), to the mail item during creation of the mail item, [{page 1, [0004]}, identity certificate];

sending the mail item to a mail room, (data center), for final processing prior to submitting the mail item to the carrier for the special service delivery, [{page 1, 0004}, identity certificate can be used by the carrier for delivering in the data center] ;

automatically detecting at the mail room the special service indicator on the mail item and determining the special service delivery required based on the detection of the special service indicator, [{page 1, [0004]}, the information contained in the identity certificate can be used by the carrier for delivering and billing in the data center];

applying at the mail room a unique identifier to the mail item, the unique identifier including an electronic address of a company server, [{page 1, [0004]} the identity certificate is printed on a label];

submitting the mail item with the unique identifier thereon to the carrier for the special service delivery [{page 1, [0004]}, the information contained in the identity certificate can be used by the carrier for delivering].

Gelfer does not explicitly disclose a unique office worker generated identifier, however, information as to “a unique office worker generated identifier” is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3)

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a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of who or what generates the identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to generate identifiers by office workers because who generates the identifiers does not functionally relate to the steps in the method claimed and because the subjective interpretation of unique office generated identifier does not patentably distinguish the claimed invention.

Gelfer does not explicitly disclose receiving from the carrier at the electronic address (barcode) obtained by the carrier from the unique identifier on the mail item information relating to the location of the mail item; storing the information relating to the location of the mail item at the company server; and providing the office worker with access to the company server to obtain the information relating to the location of the mail item.

However, Baghai discloses in column 1, lines 34-43 that a performance monitoring system the uses a client/server architecture across a network including a plurality of computers. Baghai also discloses in the changeless section, that a data collector process collects and stores data from the monitored process. In addition, Baghai mentions in column 2, lines 26-30 that if a user needs to monitor the performance there is more then workstation available to gain access.

Although Baghai does not explicitly note that an electronic address is attached to the item, one skilled in the art at the time of the invention understands that monitoring is done using a barcode, which is used in place of a URL. In order to gain access for tracking purposes the client/server is utilized.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Gelfer's method and system in conjunction with Baghai's system and method to emulate an invention that deals with using a performance system that has attached a identity certificate to form a invention that clearly relates to tracking an item with an indicator, in order to make an invention more efficient.

As Per Claim 2, Golfer does not explicitly mention a method wherein the special service indicator is a specific color associated with the special service delivery.

However Gelfer discloses a method wherein identity certificate is created by a franking machine that is printed on the mail item during creation of the mail item that has data stored within for purposes of delivery and billing which is created at the data center explained on page 1 section [0004].

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include indicator that is color correlated as taught by Gelfer with motivation being having a system that is able to associate a color indicator with a delivery path.



As Per Claims 3- 4, Gelfer does not explicitly disclose a method wherein at the mail room (data center) the specific color is automatically detected and identified to determine the special service delivery required by the mail item.

However, Baghai discloses a data collector process which collects and stores data from a monitoring process, wherein the data collected allows a user to control the frequency of collection for each of the different types of the collected data and gathers the collected in data in parallel from the monitored process located in the {abstract}. This suggests that although a specific color is not used to determine service delivery, but instead a monitored process is used to collect and sort data to the proper delivery station.

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include the monitoring device that is able to collect and sort by specific coloring as taught by Baghai et al. with motivation of sorting items correlated by the coloring.

As Per Claim 5, Gelfer discloses a method wherein the special service indicator is a label, [{page 1, [0011]} identity codes are printed in the form of bar-codes on self adhesive labels which can removed].

As Per Claim 6, Gelfer discloses a method wherein the special service indicator is printed on the mail item, [{page 1, [0011]} identity codes are printed in the form of bar-codes on self adhesive labels which can removed].

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As Per Claim 7, Golfer discloses a method wherein the special service indicator is machine readable, [{page 1, [0089]}, readers can be provided at one or more delivery stations for reading the identity codes].

As Per Claim 8, Gelfer does not explicitly disclose a method as recited wherein the information relating to the mail item includes an image of the mail item.

However, Baghai does teach on page 3 lines 20-35 that a computer program and a computer system are used for communication and storage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a system that is fully cable of creating an image of the mail item to be delivered providing the image is stored in the database for later usage as taught by Baghai with the motivation of providing an image to an client.

As Per Claim 9, Gelfer discloses a method wherein the information relating to the location of the mail item further includes date, time, and location data, [{page 1, [0009]}, allowing monitoring of the exact route of the mail piece. Used for tracking and tracing]. This suggests that the location of the mail piece can always be tracked. Also on {page 1, [0009]}, that a storage memory can be used to store information about the mail pieces.

As Per Claim 11, Gelfer discloses a method for tracking a special service delivery by a carrier of a mail item created by an office worker, the method comprising the steps

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of: applying a first special service indicator to the mail item during creation of the mail item, [{page 1, [0005]}, a bar code can be printed in some manner during the creation of the postage meter indicia];

sending the mail item to a mail room for final processing prior to submitting the mail item to the carrier for the special service delivery, [{page 1, [0007]}, the label is affixed during franking the label will be removed after delivery of the letter;

automatically detecting the first special service indicator on the mail item and determining the special service delivery required based on the detection of the first special service indicator, [{page 1, [0007]}, the identity code will then be read when the carrier returns to the local post office, it then can be used for tracking and tracing purposes];

applying at the mail room a second special service indicator to the mail item, the second special service indicator including an identification for the carrier of the special service delivery required and a unique identifier including an electronic address of a company server, [{page 1, [0011]}, has a printer for printing indicia on mail as well as identity codes on labels];

submitting the mail item with the unique identifier thereon to the carrier for the special service delivery, [{page 1, [0011]}, has a printer for printing indicia on mail as well as identity codes on labels];

receiving from the carrier at the electronic address obtained by the carrier from the unique identifier on the mail item information relating to the location of the mail item,

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[{page 1, [0007]} tracking can be done by sending a message to the sender informing the sender about delivery].

Gelfer does not explicitly mention storing the information relating to the location of the mail item at the company server; and providing the office worker with access to the company server to obtain the information relating to the location of the mail item.

However, Baghai suggest that in column 1, lines 30-45} that monitoring system using a server, which collects data and stores data. In addition, in column 2, lines 35-43, that the server enables distribution and gathering data then share the data.

Therefore, one skilled in the art the time the invention was made to include storing information related to the location of the mail item as taught by Baghai with motivation of having a system that is able to store data relating to the location and time of delivery.

As Per Claims 12-13, Gelfer does not explicitly disclose a method wherein the office worker obtains the information relating to the location of the mail item using the unique identifier.

However, Gelfer teaches on page 1, [0004], an identity code for the piece of mail can be included in the identity certificate, selectively in barcode form used for searching for a piece of mail.

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include delivery path (location). This suggest that data pertaining to location, postage and other pertinent data can be retrieve as taught by

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Golfer with motivation being having a system that can store and retrieve information about all pieces of mail during delivery at the local post office {page 1, [0009]}.

As Per Claims 10 and 14-16, Gelfer does not explicitly disclose a method wherein the first special service indicator is a specific color associated the special service delivery or wherein at the mail room the specific color is automatically detected and identified to determine the special service delivery required by the mail item or wherein the specific color is selected from a plurality of different colors, each of the plurality of different colors serving as an indicator of a different special service delivery requirement.

However, Baghai discloses a data collector process which collects and stores data from a monitoring process, wherein the data collected allows a user to control the frequency of collection for each of the different types of the collected data and gathers the collected in data in parallel from the monitored process located in the {abstract}. This suggests that although a specific color is not used to determine service delivery, but instead a monitored process is used to collect and sort data to the proper delivery station.

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include the monitoring device that is able to collect and sort by specific coloring as taught by Baghai et al. with motivation of sorting items correlated by the coloring.

As Per Claim 17, Gelfer discloses a mailing machine comprising: means for applying postage to a mail item having a first special service indicator thereon; Gelfer discloses a means for transporting mail items to the applying means, [{the identities codes are printed in the form of bar codes on labels, {{0010}}]; Gelfer discloses a means for detecting the first special service indicator and for determining a special service delivery required based on the detected special service indicator, [{allowing monitoring of the exact route of the piece of mail , this allows the sender to always check where the mail piece appears, {0009}}]; and Gelfer discloses a means for applying a second special service indicator to the mail item, the second special service indicator including an electronic address and an identification for the carrier of the special service delivery required [{a storage memory can be used to store information about all pieces of mail during delivery in a large database which can accessed by the carrier an by the sender or the sender's local post office {0009}}].

As Per Claims 18-19, Gelfer does not explicitly teach a mailing machine wherein means for detecting and determining detects the specific color and correlates the specific color to the special service delivery required by the mail item.

However, Baghai et al. discloses a data collector process which collects and stores data from a monitoring process, wherein the data collected allows a user to control the frequency of collection for each of the different types of the collected data and gathers the collected in data in parallel from the monitored process located in the {abstract}. This suggests that although a specific color is not used to determine service

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delivery, but instead a monitored process is used to collect and sort data to the proper delivery station.

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include the monitoring device that is able to collect and sort by specific coloring as taught by Baghai et al. with motivation of sorting items correlated by the coloring.

As Per Claims 20-21, Gelfer does not explicitly disclose a mailing machine (franking machine) wherein the electronic address is a URL.

However, Gelfer discloses on page 1, [0004] that an identity code is attached to the item and is in form of a barcode, (which can be used as an URL). This suggests that Gelfer is using barcode as a method for tracking. An electronic address (URL) is used to maintain the position of the item.

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include the electronic address which is the URL for providing tracking of the item as taught by Gelfer with the motivation of providing server access for tracking of the item.

As per claim 22, Gelfer discloses a method as recited in claim 1, wherein the mail item is in a receptacle containing other mail items (paragraphs [0016],[0020]; FIG.1).

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As per claim 23, Gelfer discloses a method as recited in claim 22, wherein the location of the receptacle is determined (paragraph [0020]).

As per claim 24, Gelfer discloses a method as recited in claim 23, wherein the location of the mail item is determined by knowing the location of the receptacle (paragraphs [0018]-[0020]).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



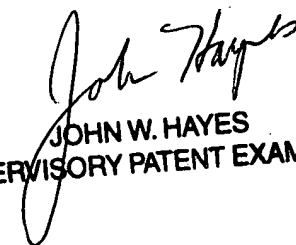
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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FAN 01/22/2007



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